



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 13/027,127 | 02/14/2011 | James Wilson | 06998-P0005B | 6202 |

24126 7590 10/26/2017
ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD, CT 06905-5619

| |
|----------|
| EXAMINER |
|----------|

LINDSEY III, JOHNATHAN J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3629

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

10/26/2017

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentpto@ssjr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES WILSON, JEFFREY MCNEILL, MICHAEL DAVIS,
MARK SILVA, and GENEVIEVE C. COMBES¹

Appeal 2016-004335
Application 13/027,127
Technology Center 3600

Before JASON V. MORGAN, JOSEPH P. LENTIVECH, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 10, 11, 13, 14, 21, 23, 24, 26, and 27, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify ZipRealty LLC as the real party in interest. App. Br. 2.

Introduction

Appellants describe the invention as relating “to methods and systems for transmitting automated alerts related to property locations during an agent’s visit to such locations.” Spec. ¶ 3. Appellants describe features of an embodiment of the invention as follows.

[T]he agent is relieved of the hassle of having to identify specific clients who may be interested in a property that the agent is currently viewing. The agent simply has to activate the location alert feature, and the real estate service automatically captures information about the current location, identifies potential clients that may be interested in the current location, and blasts out personalized alerts with information that the clients would not otherwise be able to access.

Id. ¶ 11.

Claim 10 is illustrative of the pending claims:

10. A method of communicating information about a real estate property by a real estate agent to potential purchasers, the method comprising:

detecting a current location of the real estate agent using geo-location capabilities within a mobile device carried by the real estate agent;

prompting the real estate agent to record, via the mobile device, multimedia information associated with the real estate agent’s visit to a specific MLS-listed property corresponding to the detected geographic location of the real estate agent;

receiving, by a computer system of a real estate service, the multimedia information associated with the specific MLS-listed property recorded via the mobile device;

retrieving, from a database in communication with the computer system of the real estate service, a list of clients of the real estate agent;

identifying, from the list of clients of the real estate agent, a prospective real estate buyer with potential interest in

purchasing the specific MLS-listed property based on preference information identified from a prior search history of the prospective real estate buyer; and

causing, by the computer system of the real estate service, an alert to be transmitted to the prospective real estate buyer based on the prospective real estate buyer being identified as having potential interest in purchasing the specific MLS-listed property, the alert including the multimedia information associated with the real estate agent's visit to the specific MLS-listed property.

App. Br. 42 (Claims App'x).

Rejections and Prior Art References

Claims 10, 11, 13, 14, 21, 23, 24, 26, and 27 stand rejected under 35 U.S.C. § 101 as directed to ineligible subject matter. Final Act. 2–3; *see also* Ans. 2–6 (issuing new grounds of rejection under 35 U.S.C. § 101 for these claims).

Claims 10, 11, 13, 14, 21, 23, 24, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over by Wilson (US 2011/0275441 A1; Nov. 10, 2011), Craig et al. (US 2010/0217686 A1; Aug. 12, 2010), Otto et al. (US 2007/0255581 A1; Nov. 1, 2007), and Skillen et al. (US 7,469,245 B2; Dec. 23, 2008). Final Act. 4–15.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions of reversible error. We disagree with Appellants' conclusions. Instead, we adopt the Examiner's findings and reasons: (a) for the 35 U.S.C. § 101 rejection, as set forth in the Answer; and (b) for the 35 U.S.C. § 103(a) rejection, as set forth in the Final Rejection and as set forth in the Answer. We highlight the following for emphasis.

The 35 U.S.C. § 101 Rejection

“Issues of patent-eligible subject matter are questions of law and are reviewed without deference.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1369 (Fed. Cir. 2011). To determine if a claim recites patentable subject matter under 35 U.S.C. § 101, the Supreme Court has set forth a two-part test. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

1. Step One of the Alice Analysis

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice*, 134 S. Ct. at 2355. A court must be cognizant that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas” (*Mayo Collaborative Servs. v. Prometheus Lab., Inc.*, 566 U.S. 66, 71 (2012)), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

The Examiner finds the claims “are directed to two abstract ideas” as follows:

The “prompting the real estate agent tor record, via the mobile device, multimedia information associated with the real estate agent’s visit to a specific MLS-listed property . . .” step broadly describes a method for organizing human activities. The courts previously found certain concepts relating to managing human behavior abstract. . . . The “identifying . . . a prospective real

estate buyer with a potential interest in purchasing the specific MLS-listed property based on preference information . . .” and “causing . . . an alert to be transmitted to the prospective real estate buyer . . . the alert including multimedia information . . .” steps could also be understood as describing a method for comparing new and stored information and using rules to identify options. These methods are also abstract ideas. . . .

Ans. 3 (internal ellipses in original, ending ellipsis added). The Examiner similarly identifies abstract ideas to which dependent claims 11, 13, 23, 24, 26, and 27 are drawn. *Id.* at 5–6.

a) Prima Facie Case

Appellants argue the Examiner fails to establish a prima facie case for unpatentability under § 101 because the identification of the allegedly abstract idea of the independent claims is conclusory and unsupported.

Reply Br. 3–5, 17–18. We disagree. As the Federal Circuit has clarified,

“the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Patent and Trademark Office (“PTO”) satisfies its initial burden of production by “adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond.” *Hyatt*, 492 F.3d at 1370. In other words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. That section “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original).

Appellants contend the Examiner’s identification of two abstract ideas to which the claims are directed lacks “evidentiary support or analysis” and “thus fails to establish a prima facie case that the claims are directed to an abstract idea.” Reply Br. 3. We disagree. The Examiner’s findings and reasons in the new ground of rejection along with the discussion in the Response to Argument section in the Answer (*see* Ans. 2–9 (*inter alia*, comparing Appellants’ claims to guidance provided from prior judicial precedent and published guidance from the USPTO on Subject Matter Eligibility)), however, are not “so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *In re Jung*, 637 F.3d at 1362.

Appellants also contend the Examiner fails to establish a prima facie case by not providing required “authoritative documentation to support the Examiner’s § 101 rejection.” Reply Br. 4 (referencing the Administrative Procedure Act (APA), 5 U.S.C. § 500 et seq., *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000), *In re Dembiczak*, 175 F.3d 994, 999-1000, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), and *Donahue v. Barnhart*, 279 F.3d 441, 446 (7th Cir. 2002)). We again disagree. The fact-finding is subject to review for “substantial evidence,” not support by “authoritative documentation.” *See, e.g., in re Gartside*, 203 F.3d at 1308. Further, we note Examiners may rely on their own technical expertise, e.g., to describe the knowledge and skills of a person of ordinary skill in the art. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003) (Examiners are “persons of scientific competence in the fields in which they work,” and their findings are “informed by their scientific knowledge”); *see also* MPEP § 2141 (II)(C)

(Resolving the Level of Ordinary Skill in the Art) *and* MPEP § 2144.03 (“an examiner may . . . rely on ‘common knowledge’ in making a rejection”).

There is ample support for the Examiner’s findings and reasons in the new ground of rejection.

Accordingly, we find the Examiner’s new ground of rejection establishes a *prima facie* case of unpatentability under § 101 of claims 10, 11, 13, 14, 21, 23, 24, 26, and 27.

b) Whether the Claims are Directed to an Abstract Idea

Appellants argue the Examiner fails to comply with examination guidelines, which instruct examiners “to ‘refer to the body of case law precedent in order to identify abstract ideas by way of **comparison to concepts already found to be abstract**’” (quoting the USPTO guideline “July 2015 Update: Subject Matter Eligibility,” § III, ¶ 1). Reply Br. 5–6. Appellants contend the Examiner provides “no comparison of these alleged abstract ideas to any other concept, much less to any concept that the courts have already found to be abstract.” *Id.* We disagree. The Examiner’s new ground of rejection plainly compares the idea of managing human behavior (identified for the claim requirements related to prompting of the agent) to *In re Meyer*, 688 F.2d 789 (CCPA 1982) and the idea of comparing information and using rules to identify options (identified for the claim requirements related to identifying of a buyer and transmitting an alert) to *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. App’x 950 (Fed. Cir. 2014) (nonprecedential). *See* Ans. 3.

Appellants argue the Examiner’s identification of the abstract idea to which claim 10 is drawn erroneously oversimplifies the claim, which includes significant limitations the Examiner glosses over. Reply Br. 9–11.

Appellants identify “detecting a current location,” “receiving . . . multimedia information associated with the specific MLS-listed property,” and “identifying, from the list of clients . . . based on preference information identified from a prior search history” as recited limitations that are “not simply directed to” the abstract ideas identified by the Examiner. *Id.* at 10–11. This is unpersuasive.

We look to whether the claims focus on a specific means or method that improves the relevant technology, or instead is directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). As the Examiner finds in the new ground of rejection, and we agree, the limitations to which Appellants point are conventional functions of receiving data (e.g., receiving “current location” using “geo-location capabilities”) and processing data (e.g., processing a “list of clients” based on “search history”), claimed in a manner that uses general, conventional technology. Ans. 4. While it is possible that such limitations, alone or as an ordered combination, may amount to “something more” under the second prong of the *Alice* analysis, such recitations do not result in the claim being “drawn to” something other than the abstract ideas identified by the Examiner.

Claim 10 is unlike the claims at issue in *Enfish*, which provided a unique software database table structure that improved existing software database technology and, thus, were “directed to a specific implementation of a solution to a problem in the software arts,” and not unpatentably directed to an abstract idea. 822 F.3d at 1339. Claim 10 does not recite any unique software technology, instead it recites generic underlying technology.

Claim 10 is also unlike the claims in *DDR Holdings v. Hotels.com L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), in which the Federal Circuit found the claims at issue were “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” because they addressed a technical issue unique to Internet website problems. 773 F.3d at 1257. Here, claim 10 uses conventional technologies to address issues of communication between real estate agents and clients or potential purchasers, without solving any underlying technological issues.

Thus, we agree with the Examiner that claim 10 is directed to an abstract idea under the first prong of *Alice*.

2. Step Two of the Alice Analysis

In the second step, we consider the claim elements “both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). The Supreme Court has “described step two of this analysis as a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* (quotation omitted).

Appellants argue the claim 10

limitations recite a specific way for identifying recipients for electronically transmitted information (e.g., “based on preference information identified from a prior search history of the [recipient]”) that addresses an Internet-centric challenge related to dissemination of pertinent information. Further, the specific way for identifying recipients for electronically transmitted information is necessarily rooted in computer technology because, as recited by claim 10, a “prospective real estate buyer” is identified “based on preference information

identified from a *prior search history* of the prospective real estate buyer.”

Reply Br. 15 (brackets in original).

This argument is unpersuasive. The Federal Circuit cautioned in *DDR Holdings* “that not all claims purporting to address Internet-centric challenges are eligible for patent.” 773 F.3d at 1258. Claim 10 is unlike the claims at issue in *DDR Holdings*, which addressed a challenge that pertained only to the realm of the Internet, with no real-world analog. Here, the requirement for “identifying, from the list of clients of the real estate agent, a prospective buyer with potential interest in purchasing the specific MLS-listed property based on preference information, from a search history of the prospective real estate buyer” is analogous to the real-world practice of real estate agents who, when a certain type of property comes on the market, such as lakefront property, identify and contact their clients who previously expressed interest in and/or asked the agent to notify them about such properties when they become available. *See Enfish*, 822 F.3d at 1336 (identifying issue as whether the “focus of the claims is on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity”); *compare DDR Holdings*, 773 F.3d at 1257 (“these claims stand apart because they do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet”).

Appellants also argue that “[t]he specific way for verifying the physical presence of the real estate agent is necessarily rooted in computer technology because, as recited by claim 10, the ‘current location of the real estate agent’ is detected ‘using geolocation capabilities within a mobile

device carried by the real estate agent” and “claim 10 results in the transmission of information that is unconventionally confined to a select group of interested recipients, and in doing so, the application of claim 10 results in a reduction in use of both computational and network resources as compared with conventional practice.” Reply Br. 16. These requirements to which Appellants point, however, are routine applications of well-known technology to the abstract ideas to which claim 10’s “method of communicating information about a real estate property by a real estate agent to potential purchasers” is directed. By itself, application of well-known technology to automate a business method does not “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78).

Thus, we agree with the Examiner’s determination that the steps of claim 10, both individually or as an ordered combination, do not recite “significantly more” than routine use of well-known technologies to automate a business method of a real estate agent that otherwise is directed to unpatentably abstract ideas. Accordingly, we sustain the § 101 rejection of claim 10, and also of claims 11, 13, 14, 21, 23, 24, 26, and 27, which Appellants do not separately argue.

The 35 U.S.C. § 103(a) Rejection

Appellants argue the Examiner errs in the rejection of claim 10:

- (1) in finding the cited art teaches or suggests “identifying, from the list of clients of the real estate agent, a prospective real estate buyer with potential interest in purchasing the specific MLS-listed property based on preference information identified from a prior search history of the prospective real estate buyer,” as recited;

- (2) in finding the cited art teaches or suggests “causing . . . an alert to be transmitted to the prospective real estate buyer based on the prospective real estate buyer being identified as having potential interest in purchasing the specific MLS-listed property, the alert including the multimedia information associated with the real estate agent's visit to the specific MLS-listed property,” as recited; and
- (3) in finding one of ordinary skill would have been motivated to combine Otto with Wilson and Craig.

App. Br. 30–40.

1. “*Identifying . . . a Prospective Real Estate Buyer . . .*”
 - a) “*From the List of Clients of the Real Estate Agent*”

In rejecting claim 10, the Examiner finds Otto teaches “identifying, from the list of clients of the real estate agent, a prospective real estate buyer with potential interest in purchasing the specific MLS-listed property based on preference information,” as recited. Final Act. 5–6 (citing Otto ¶¶ 35–40, Figs. 3A–B, 6, 9). Appellants argue that the Examiner errs because “the ‘buyer profiles’ stored in the ‘buyer database’ of Otto are simply ‘buyers participating in the online real property marketplace’ of Otto, and these buyers are not described by Otto as being ‘clients of a real estate agent.’” App. Br. 32 (citing Otto ¶ 29). Appellants contend that because “it is an objective of *Otto* to eliminate real estate agents from real estate transactions all together,” , the Examiner errs in finding Otto teaches “the list of clients of the real estate agent,” as recited. *Id.*

This is unpersuasive. Each reference cited by the Examiner must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The relevant inquiry is whether the claimed subject matter

would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Claim 10 does not recite “identifying, from *a* list of clients of the real estate agent,” as Appellants argue (App. Br. 32), rather it recites “identifying . . . from *the* list.” The Examiner relies on Craig for teaching retrieval of “a list of clients of the real estate agent” from a database, as recited in the first instance. Final Act. 5 (citing Craig ¶¶ 16, 27–28, Fig. 4). One cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references. *In re Keller*, 642 F.2d at 425.

As the Examiner finds, and we agree, Otto teaches “a matching engine that identifies a subset of clients interested in buying a specific property.” Final Act. 6; *see also id.* at 5 and Otto ¶¶ 32–41, Figs. 3A–C, 6. Appellants provide no persuasive argument or evidence that combining Otto’s “matching engine” with the list of clients of a real estate agent from Craig’s “system for managing communication between a real estate agent and one or more clients” (Craig Abstract) was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 419); *see also KSR*, 550 at 420–21 (skilled artisans can “fit the teachings of multiple patents together like pieces of a puzzle” because the skilled artisan is “a person of ordinary creativity, not an automaton”).

b) “From a Prior Search History”

The Examiner finds that Otto teaches identifying a prospective buyer based on preference information, and that Skillen teaches that such preference information is “identified from a prior search history of the

prospective real estate buyer,” as recited. Final Act. 5–7 (citing *Skillen* 2:43–46, 54–57, 66–67; 5:13–23; claims 1, 7). Appellants argue the Examiner errs because

Skillen generally discusses user profile data that may include or may be derived from a “prior searching history.” However, *Skillen* does not discuss or even contemplate using such “user preference data” to “identify[] . . . a prospective real estate buyer with potential interest in purchasing **the specific MLS-listed property**,” let alone identifying a “prospective real estate buyer” “from a list of clients of the real estate agent,” as recited by claim 10.

App. Br. 33 (brackets and ellipsis in original).

This argument is unpersuasive because the Examiner relies on Otto, not *Skillen*, for teaching that a prospective buyer is interested in purchasing the specific MLS-listed property based on preference information. Final Act. 5–6; see *In re Keller*, 642 F.2d at 425.

Appellants further argue the Examiner errs because “*Otto* does not discuss or even contemplate storing a history of buyer’s searches on which *Skillen*’s alleged teaching of ‘deriving a user’s preference information’ may be performed.” App. Br. 33–34. We disagree. An ordinarily skilled artisan would have understood *Skillen*’s unambiguous statement that “user preference data is derived from prior searching history” (*Skillen* 7:18–19 (claim 7)) to teach claim 10’s requirement for “preference information identified from a prior search history,” as recited. In combination with the teachings of Otto, the artisan would have understood *Skillen* to teach identifying preference information from search history information “of the prospective real estate buyer,” as recited. *In re Merck*, 800 F.2d at 1097. “Storing a history of buyer’s searches,” which Appellants argue Otto does not teach, is not a recited requirement and, regardless, to the extent such a

requirement implicitly is necessary, an ordinarily skilled artisan would have understood Skillen implicitly to teach it. *See* Skillen claim 7.

Thus, the Examiner does not err in finding the combination of Otto and Skillen teaches all limitations of claim 10’s “identifying . . . a prospective real estate buyer” step, as recited in claim 10.

2. *“Causing . . . an Alert to be Transmitted”*

The Examiner finds “the proposed combination of Wilson, Craig, Otto and Skillen” teaches “causing . . . an alert to be transmitted to the identified prospective real estate buyer based on the prospective real estate buyer being identified as having potential interest in purchasing specific MLS-listed property, the alert including multimedia information associated with the real estate agent’s visit to the specific MLS-listed property,” as claim 10 recites. Final Act. 7–8 (citing Craig ¶¶ 16, 18, 27, 28, Figs. 3B, 4; Wilson ¶¶ 79, 95, 300; Figs. 19–24). Appellants argue that “although Craig does discuss notes being sent to clients, Craig does not discuss notes regarding a specific property being ‘transmitted to the prospective real estate buyer based on the prospective real estate buyer being identified as having potential interest in purchasing the specific MLS-listed property,’ as recited.” App. Br. 35.

This argument is unpersuasive because it does not address the combined teachings of Craig and Otto, and specifically the Examiner’s finding that Otto teaches identifying a prospective real estate buyer with potential interest in the specific MLS-listed property. *See* Final Act. 5–7.

Appellants also argue “[f]urthermore, the ‘notes’ in Craig are clearly described as being ‘textual’ notes, and Craig does not describe these ‘textual notes’ as including ‘multimedia information associated with the real estate agent’s visit to the specific MLS-listed property,’ as recited.” App. Br. 35.

This argument is unpersuasive because it does not address the Examiner’s finding that Wilson’s teaching of providing “written feedback, videos, and pictures” teaches the multimedia information. Final Act. 6–8 (citing Wilson ¶¶ 79, 95, 300).

Regarding Wilson, Appellants contend its “merely allowing players of a game to access information about a property based on their participation in the game” “is not the same as ‘causing . . . an alert to be transmitted to the prospective real estate buyer based on the prospective real estate buyer being identified as having potential interest in purchasing the specific MLS-listed property,’ as recited.” App. Br. 35 (ellipsis in original). First, we note that Appellants characterize Wilson too narrowly. Wilson addresses the need for “a system that utilizes these databases and locating devices of house-hunters in order to encourage and facilitate the dissemination of information between house-hunters, sellers, informed neighbors, and agents” (¶ 8) and “provide[s] a new way for agents to interact with existing clients” (¶ 73). Second, Appellants’ argument is unpersuasive because the Examiner relies on Craig for teaching sending notifications. *See* Final Act. 7; *see also* Ans. 11. Craig specifically teaches a real estate agent can set notification settings for clients which, as shown in Fig. 3A, can be configured to have notifications sent automatically to clients when a new match arrives. *See* Craig ¶ 27, Fig. 3A.

Appellants assert that Otto and Skillen were not relied upon in the rejection with respect to the “*based on the prospective real estate buyer being identified as having potential interest in purchasing the specific MLS-listed property*” limitations of claim 10’s “causing . . . an alert to be transmitted” step. App. Br. 37–38. Appellants are mistaken—the Examiner

specifically relies on all four references. *See* Final Act. 7. Appellants’ contention that, regardless, “Otto and Skillen do not remedy the deficiencies of Wilson and Craig with respect to the above referenced element” because “Otto and Skillen fail to discuss or even contemplate ‘identifying, from the list of clients of the real estate agent, a prospective real estate buyer with potential interest in purchasing the specific MLS-listed property,’ as recited” is unpersuasive for the reasons discussed above for the “identifying . . . a prospective real estate buyer” step. App. Br. 38.

Thus, the Examiner does not err in finding the combination of Wilson, Craig, Otto, and Skillen teach all limitations of the “causing . . . an alert to be transmitted” step, as recited in claim 10.

3. *Motivation to Combine Otto with Wilson and Craig*

Appellants argue the Examiner errs in finding an ordinarily skilled artisan would have been motivated to combine Otto with Wilson and Craig as proposed by the Examiner. App. Br. 38–40.

Craig concerns a “system for ***managing communication*** between ***a real estate agent*** and one or more clients.” In contrast, the goal of Otto . . . is to “remove [real estate] agents as the gatekeepers to communication between potential parties to a real estate transaction.” Thus, one of ordinary skill in the art would not be motivated to combine the teachings of *Otto* with the teachings of *Craig* because *Otto* clearly teaches away from the alleged teachings of *Craig*. In other words, the teachings of the two references are in conflict – *Craig* teaches managing communications of a real estate agents with other parties (e.g., other agents), whereas *Otto* teaches ***eliminating*** the real estate agent from such communications. Consequently, due to this clear conflict between the references, one of ordinary skill in the art would not be motivated to combine the teachings of *Otto* with *Wilson* and *Craig*.

App. Br. 39.

A teaching away requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). “A finding that two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another.” *Nat’l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004). “[O]bviousness must be determined in light of all the facts, and there is no rule that a single reference that teaches away will mandate a finding of nonobviousness. Likewise, a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006).

Here, the invention of claim 10 is directed to two-way communication between an agent and potential purchasers. There is no criticism in Otto of such an invention. There is no dispute as to whether Otto is analogous art that an ordinarily skilled artisan would have considered along with Wilson and Craig. The Examiner relies on Wilson and Craig for the requirements of five of the six steps recited in claim 10, and relies on Otto as a secondary reference for the remaining step.

Otto’s advantage of disintermediating agents from between buyers and sellers is irrelevant to the proposition for which the Examiner cites it, *viz*, its teaching of identifying prospective buyers with potential interest in specific MLS-listed property based on preference information. Ordinarily skilled artisans would have recognized that a teaching of identifying prospective buyers based on preference information is relevant and useful both to a seller and to a real estate agent. In other words, that Otto may teach an advantage of disintermediating an agent from between a potential

buyer and a seller would not have discouraged the artisan from combining Otto's technical teachings related to communicating information between potential buyers and a seller with the teachings of Wilson and Craig related to communicating information between potential buyers and a real estate agent. On the facts here, we agree with the Examiner that "although Otto and Craig may have been inspired by different concerns when arriving at their inventions, such differences do not constitute a teaching away from the proposed combination." Ans. 12.

4. Conclusion

Accordingly, we sustain the § 103 rejection of claim 10. For the same reasons we sustain the § 103 rejection of claims 11, 13, 14, 21, 23, 24, 26, and 27, for which Appellants offer no arguments separate from claim 10.

DECISION

For the above reasons, we affirm the rejections of claims 10, 11, 13, 14, 21, 23, 24, 26, and 27 under 35 U.S.C. §§ 101 and 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED